

### REMARKS

Claims 1-3, 5-14, and 16-22 remain pending and stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. This rejection is respectfully traversed.

The definiteness requirement of 35 U.S.C. § 112, second paragraph, is satisfied provided that persons skilled in the art would understand, with at least reasonable precision, that which is encompassed by the claim. *United States v. Teletronics*, 857 F.2d 778, 8 U.S.P.Q.2d 1217 (Fed. Cir. 1988). As the Federal Circuit explained in *Modine Mfg. Co. v. United States Int'l Trade Comm'n*, 75 F.3d 1545, 1557, 37 U.S.P.Q.2d 1609 (Fed. Cir. 1996), “a patentee has the right to claim the invention in terms that would be understood by persons of skill[.]”

The Office Action asserts that the specification does not sufficiently define what is encompassed by the term “bit” as used in the phrase “solid bit.” As described in the specification at ¶¶ 20, 23, and 46 and elsewhere, powdered tobacco can be compressed into a bit that will hold its form and which can be placed into the user’s mouth, where it disintegrates and dissolves. The application uses the term “bit” in its ordinary sense, e.g., “a small piece or quantity.” Compact Oxford English Dictionary (attached). The term “solid bit” does not require any particular shape provided that the compressed powdered tobacco holds its form and can disintegrate and dissolve in the mouth, as described in the specification.

Applicant respectfully submits that the term “bit” would be understood by persons of ordinary skill with at least reasonable precision, particularly when the term is read in light of the specification. The law requires nothing more. Reconsideration and withdrawal of this ground of rejection are respectfully requested.

Claims 1-3, 5, 9, 10, 12-14, 16, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,135,120 to Lofman (“Lofman”) in view of U.S. Patent 4,606,357 to Dusek et al. (“Dusek”). Claims 6-8 and 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lofman in view of Dusek and further in view of WO 00/15056 to Williams (“Williams”). Each of these rejections is respectfully traversed.

Lofman discloses finely divided, moistened tobacco material such as snuff tobacco (see column 2, lines 13-15 and 64-67). The tobacco material is placed into pockets 4 disposed on a rotary positioning wheel 3 and compressed while in the pockets (see column 3, lines 44-56). The tobacco is then discharged from the pockets onto a tape 17 (column 5, lines 9-12). The Office Action concedes that Lofman does not describe tobacco material containing peppermint, menthol, wintergreen, and/or spearmint flavorants.

Dusek is cited as describing a tobacco composition containing finely cut tobacco or fine grade snuff (column 4, lines 18-20). According to Dusek, the composition may include flavors such as essential oils such as peppermint oil, spearmint oil, oil of wintergreen, or mixtures thereof (column 4, lines 63-66). The Office Action acknowledges that Dusek does not describe providing flavors in the particular concentrations set forth in independent claims 1 and 12, but concludes that it would have been obvious to have selected the claimed amounts after routine experimentation to optimize flavor content and provide a pleasing taste.

A *prima facie* case of obviousness requires that all elements of a claim be taught in a prior art reference or a combination of references. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); M.P.E.P. § 2143.03.

Independent claims 1 and 12 each recite a tobacco product containing, *inter alia*, from about 0.5 to about 15 wt% menthol. Neither Lofman nor Dusek describes a tobacco product

containing menthol at any concentration. Therefore, the combination of Lofman and Dusek fails to describe or suggest the invention of independent claims 1 and 12 for at least this reason.

Moreover, to establish a *prima facie* case of obviousness, the USPTO must provide substantial evidence in support of underlying questions of fact. *In re Kotzab*, 217 F.3d 1365, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). The USPTO cannot resolve questions of facts on subjective belief and unknown authority. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2000) (“the [USPTO’s] findings must extend to all material facts and must be documented on the record, less the ‘haze of so-called expertise’ acquire insulation from accountability.”).

The Office Action cites no objective evidence in support of its assertion that it would have been obvious to have selected the claimed flavors in the claimed amounts. The Office Action leaps from a bare disclosure in Dusek of using flavoring agents in smokeless tobacco products to the unsupported conclusion that it would have been obvious to have used a combination of the three particular additives claimed in claim 1 or the three particular additives claimed in claim 12. Such reasoning is inconsistent with the requirement articulated by the Federal Circuit in *Kotzab* and *Lee* that the USPTO provide substantial evidence to support its reasoning in an obviousness rejection.

The Office Action engages in legally impermissible hindsight, using Applicant’s own disclosure as a roadmap to reconstruct the claimed invention. As the Federal Circuit cautioned in *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), “[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.” The fact finder must avoid the “insidious effect of a hindsight syndrome wherein that

which only the inventor taught is used against the teacher.” *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Because the Office Action has not pointed to objective evidence disclosing or suggesting a tobacco product containing the particular components set forth in claims 1 and 12, the Office Action fails to set forth a *prima facie* case of obviousness. Dependent claims 2, 3, 5, 9, 10, 13, 14, 16, 20, and 21 are allowable for at least the same reasons as applicable to independent claims 1 and 12.

Williams is cited as describing tobacco products having very low levels of tobacco-specific nitrosamines. Williams does not describe a smokeless tobacco product comprising a solid bit of powdered tobacco, and thus fails to remedy the deficiencies of the primary references as discussed above. Dependent claims 6-8 and 17-19 are allowable over the prior art for at least the same reasons as are applicable to independent claims 1 and 12.

None of the prior art documents, taken alone or in any combination, describes or suggests a solid bit of powdered tobacco having all of the features set forth in independent claims 1 and 12. Reconsideration and withdrawal of each of the prior art rejections are respectfully requested.

The Examiner is invited to telephone the undersigned at the number listed below if doing so would be helpful to resolve any outstanding issues.

Respectfully submitted,

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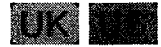
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## Compact Oxford English Dictionary

bit<sup>1</sup>

• **noun** **1** a small piece or quantity. **2 (a bit)** a short time or distance. **3 (also bit of fluff or stuff)** informal a girl or young woman.

— PHRASES **a bit** somewhat. **bit by bit** gradually. **bit on the side** informal **1** a person with whom one is unfaithful to one's partner. **2** money earned outside one's normal job. **do one's bit** informal make a useful contribution. **to bits** **1** into pieces. **2** informal very much; to a great degree.

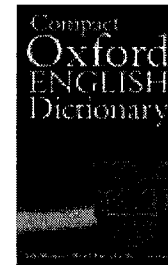
— ORIGIN Old English, bite, mouthful.

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